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Remarks

I. Status of claims

Claims 1-5, 14-18, and 29-37 are pending.

Claim 38 has been added.

II. Claim rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-5, 14-18, and 29-37 under 35 U.S.C. § 103(a) over Fields (U.S. 6,704,797) in view of Sato (U.S. 6,914,691).

Fields discloses a sever-based access manager 34 for distributing images in accordance with a server-based policy defined by one or more rules for selectively distributing different versions of an original image (see, e.g., col. 2, lines 36-58, col. 4, lines 36-43, and col. 6, lines 2-7). When a client request for an image is received, the access manager 34 evaluates a rule against client-specific data in the request (see, e.g., col. 2, lines 41-44, and col. 5, lines 26-29). If the client-specific data satisfies a condition of the rule, a specified restriction is imposed on the distribution of the image (see, e.g., col. 2, lines 44-46).

Sato discloses a color photocopier 103 that copies manuscripts that are placed on a glass surface 31 onto the surface of a recording material 7 (see, e.g., col. 3, line 22 - col. 4, line 38). The photocopier 103 includes a detecting circuit 105 that executes a pattern matching algorithm to detect the presence of a copyright indication (e.g., a mark, bar code, or character string) in image data that is captured by the photocopier 103. If the detection circuit 105 detects the presence of the copyright indication, the image data is not sent to the image forming device 103 for printing (see col. 7, lines 35-45).

A. Independent claim 1

In support of the rejection of independent claim 1, the Examiner has stated that (emphasis added):

> As per claim 1, Fields et al teach an electronic messaging system for filtering electronic messages, comprising

> a message server operable to receive and transmit electronic messages including electronic mail messages (column 3, line 65), the message server comprising an access restriction filter (column 2, lines 40-58, column 6, lines 52-54);
>
> wherein the access restriction filter is configured to detect an access restriction notice in the respective ones of the electronic messages, and, the access restriction filter being additionally configured to respond to the detection of the access restriction notice in accordance with a prescribed policy for handling electronic messages containing the detected access restriction notice (column 2, line 35 - column 3, line 15).

Thus, the Examiner has taken the position that a client request for an image or a web page that includes an image constitutes an electronic message of the type recited in claim 1. Contrary to the Examiner's statement, however, Fields' access manager 34 does not detect an access restriction notice in such a client request. Instead, the access manager 34 only compares the client-specific data associated with a given client request to the rules criteria that are stored on the server (see, e.g., col. 5, lines 26-30). The client-specific data includes "an identity of a referring page (i.e. the page from which the link to the server was selected), a client machine IP address, the identity of a third party service provider (e.g., an ISP) that provides Internet service to the client, the existence (or lack thereof) of a user authentication, a user identifier such as a cookie, or other such data" (col. 4, lines 25-32). The client-specific data does not include an access restriction notice. Consequently, there is no reasonable basis to believe that Fields' access manager 34 is configured to detect an access restriction notice in the client requests.

Thus, contrary to the Examiner's statement, Fields does not teach or suggest anything that would have led one skilled in the art at the time the invention was made to an "access restriction filter is configured to detect an access restriction notice in the respective ones of the electronic messages." Sato does not make-up for the failure of Fields to teach or suggest this feature of claim 1. Indeed, Sato does not teach or suggest anything about detecting access restrictions notices in electronic messages of the type recited in claim 1. For at least these reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) over Fields in view of Sato should be withdrawn.

The Examiner's rejection of claim 1 also should be withdrawn for the following additional reasons.

The Examiner has acknowledged that Fields "fail to teach the access restriction filter comprising a character recognizer configured to translate characters in image components of respective ones of electronic messages into computer-readable character representations and comparing the one or more translated computer readable character representations respectively produced by the character recognizer to respective representations of one or more access restriction notices stored-in memory." In an effort to make-up for this failure, the Examiner has stated that (emphasis added):

> However, Sato teach a detection process for detecting copyright restriction characters on images and executes pattern matching with characters stored in memory to impose stored restriction policies, such as prevent copying of the image (column 8, lines 9-34). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato <u>because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image</u>.

Contrary to the Examiner's statement, one skilled in the art at the time the invention was made would not have been led to combine the teachings of Fields and Sato to arrive at the inventive electronic messaging system recited in claim 1.

First, Fields does not detect access restriction notices in the client requests for images or web pages that include images and Sato does not teach or suggest anything that would have led one skilled in the art to detect access restriction notices in such requests. Therefore, the Examiner has not pointed to any suggestion or motivation, either in Fields, Sato, or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the teachings of Fields and Sato in a way that would result in the inventive subject matter defined in claim 1.

Second, the Examiner's asserted motivation for combining Fields and Sato (i.e., "because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image") does not appear in either of the cited references. In the absence of a proper motivation for combining the teachings of Fields and Sato, it appears that the Examiner improperly has engaged in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together elements from the prior art in a manner that reconstructs the invention recited in claim 1 only with the benefit of hindsight.

Third, one skilled in the art at the time the invention was made would not have been motivated to combine the teachings of Fields and Sato in the manner proposed by the Examiner because such a combination would not serve any useful purpose whatsoever. As explained above, the client requests for images or web pages containing images do not contain the images whose access is being controlled by Fields' access manager 34. Indeed, these client requests would not be made if they already contained the images. Therefore, one skilled in the art would not have any reason whatsoever to use Sato's detection circuit 105 to detect the presence of a copyright indication in the client requests that are received by Fields' access manager 34.

For at least these additional reasons, the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) over Fields in view of Sato should be withdrawn.

B. Dependent claims 2-5, 30, and 33-35

Each of claims 2-5, 30, and 33-35 incorporates the features of independent claim 1 and therefore is patentable over Fields and Sato for at least the same reasons explained above. The Examiner's rejections of these claims also should be withdrawn for the following additional reasons.

1. Claim 2

Col. 2,lines 35-60, of Fields does not support the Examiner's contention that Fields teaches that "the access restriction filter is configured to detect in respective ones of the electronic messages an access restriction notice indicating ownership of at least a portion of the respective ones of the electronic message." Fields does not even hint that the access manager 34 detects an access restriction notice indicating ownership of at least a portion of a client request.

2. Claim 3

The disclosure in col. 1, lines 35-41, and col. 6, lines 50-54, does not support the Examiner's contention that Fields teaches that "the access restriction filter is configured to

detect a copyright notice in respective ones of the electronic message." The mere statement of the rights of copyright owners in col. 1, lines 35-41, does not constitute a teaching that the access manager 34 is configured to detect a copyright notice in a client request for an image or a web page containing an image. In addition, in col. 6, lines 50-54, Fields discloses that a user may create a version of an image that includes a symbol overlay, such as a copyright symbol overlay. Contrary to the Examiner's statement, however, this disclosure does not constitute a teaching that the access manager 34 is configured to detect a copyright notice in a client request for an image or a web page containing an image.

3. Claim 4

The disclosure on col. 2, line 35 - col. 3, line 15, does not support the Examiner's contention that Fields teaches that "the access restriction filter is configured to detect the copyright notice by comparing one or more characters in the respective ones of the electronic messages to respective characters of one or more copyright notices stored in memory." Indeed, the cited disclosure does not teach anything about detecting copyright notices in client requests for images or web pages containing images, much less anything about comparing one or more characters in the respective ones of the electronic messages to respective characters of one or more copyright notices stored in memory.

4. Claim 5

The disclosure on col. 4, line 44-67, does not support the Examiner's contention that Fields teaches that "the access restriction filter is configured to detect the copyright notice by comparing characters in a header component of the respective ones of the electronic messages with respective characters of the one or more stored copyright notices." Indeed, the cited disclosure does not teach anything about detecting copyright notices in client requests for images or web pages containing images, much less anything about comparing characters in a header component of the respective ones of the electronic messages with respective characters of the one or more stored copyright notices. Instead, this disclosure merely describes how an image version is served by the access manager 34 in response to a client request.

5. Claim 30

Fields does not teach or suggest anything that would have led one skilled in the art to believe that the client requests for images or web pages containing images included any of the access restriction notices recited in claim 30. Therefore, such a person would not have had any reason whatsoever to combine Fields and Sato in the manner proposed by the Examiner in support of the rejection of claim 30.

6. Claim 33

The disclosure on col. 4, line 34-39, does not support the Examiner's contention that Fields teaches that "at least one of the electronic messages comprises a primary message and at least one attachment, and the access restriction filter is configured to compare characters in the primary message and characters in the at least one attachment to respective characters of the one or more stored access restriction notices." Indeed, the cited disclosure does not teach anything that would have led one skilled in the art to believe that any of the client requests includes a primary message and at least one attachment. Instead, this disclosure teaches that a set of image versions are stored at the server and that each image version is associated with distribution criteria.

7. Claim 34

Claim 34 recites that "the access restriction filter is configured to trigger display of a report to a user in response to the detection of the access restriction notice." As explained above, the client requests that are received by the Fields' access manager 34 do not contain access restriction notices. Therefore, one skilled in the art would not have any reason whatsoever to combine Fields with Sato in a way that would result in the display of a report to the user that is triggered in response to the detection of an access restriction notice in a client request. Contrary to the implication of the Examiner's statements in support of the rejection of claim 34, the identification of an image in a client request does not constitute an access restriction notice.

8. Claim 35

Claim 35 recites that "the access restriction filter is configured to trigger display to a user a message reporting that a corresponding one of the electronic messages cannot be transmitted because of the detection of the access restriction." In support of the rejection of claim 35, the Examiner merely has copied verbatim the statements made in support of the rejection of claim 34. These statements do not establish a *prima facie* case for the obviousness of claim 35 for at least the same reasons explained above in connection with claim 34.

C. Independent claim 14

Independent claim 14 recites features that essentially track the pertinent features of independent claim 1 discussed above. Therefore, claim 14 is patentable over Fields and Sato for at least the same reasons explained above in connection with independent claim 1.

D. Dependent claims 15-18 and 31

Each of claims 15-18 and 31 incorporates the features of independent claim 14 and therefore is patentable over Fields and Sato for at least the same reasons explained above.

E. Independent claim 29

Independent claim 29 recites features that essentially track the pertinent features of independent claim 1 discussed above. Therefore, claim 29 is patentable over Fields and Sato for at least the same reasons explained above in connection with independent claim 1.

F. Dependent claim 32

Claim 32 incorporates the features of independent claim 29 and therefore is patentable over Fields and Sato for at least the same reasons explained above.

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III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 19-2179.

Respectfully submitted,

Date: Jan 31, 2007

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